

REMARKS

Claims 80-90 are currently pending in this application and stand rejected from the non-final Office Action dated October 16, 2006. As described below, Applicants have amended herein claims 80 and 84. Applicants present those amendments and the following comments in support of the patentability of all of the pending claims.

I. Claim Amendments

Applicants have amended claims 80 and 84 to recite “a single-ply paper web having a machine direction and a cross machine direction,” which is fully supported in the original specification by at least the paragraph bridging pages 27 and 28. Applicants submit that the amendments to claims 80 and 84 do not add any new matter and that the skilled artisan would readily understand Applicants to have been in possession of the claimed subject matter at the time this application was filed. Therefore, Applicants request that the Office enter the amendments without objection.

II. Rejections under 35 U.S.C. § 112, Second Paragraph

A. “About”

The Office has rejected claims 80-90 under 35 U.S.C. § 112, second paragraph, maintaining its belief that the recitation of “at least about” is indefinite. The Office believes that the scope of “about” is unclear, particularly in view of the fact that the ranges disclosed in the specification also include the term “about.” In support of its assertion, the Office has cited MPEP § 2173.05(b) and *Amgen, Inc. v. Chugai Pharm.*

Co. Ltd., 927 F.2d 1200, 18 U.S.P.Q. 1016 (Fed Cir. 1991) ("*Amgen*") discussed therein. See Office Action at page 5. Applicants respectfully traverse this rejection.

As previously asserted, the term "about" is not a term of inherent ambiguity, particularly in certain mechanical arts, and does not render the pending claims indefinite. Moreover, in contrast to the Office's assertion, both MPEP § 2173.05(b) and the *Amgen* case support this position. In *Amgen*, the challenged patent had claim language which limited the "specific activity" to "at least about 160,000." 927 F.2d at 1217. The district court found that bioassaying, the only available method for measuring specific activity, was itself "an imprecise form of measurement with a range of error" and that the use of the term "about," coupled with the range of error already inherent in the specific activity limitation, created ambiguity. *Id.* In addition, the court also found that the patentee had introduced the term "about" into the claims late in the prosecution process and in an attempt to recapture some ambiguous scope that lay in between claims that had already been allowed and scope previously relinquished in overcoming a prior art reference. *Id.* at 1217-1218. The court found that, in view of the specific facts in that case, the combination of those two factors rendered the term "about" indefinite. However, the court explicitly stated that "we caution that our holding that the term 'about' renders indefinite claims 4 and 6 should not be understood as ruling out any and all uses of this term in patent claims. It may be acceptable in appropriate fact situations . . . even though it is not here." *Id.* at 1218.

In contrast to the facts in *Amgen*, the facts in this case do not support the conclusion that the use of the term "about" is indefinite. Unlike bioassaying, the measurement of the ratio of the longitudinal dimension to the transverse dimension is

neither imprecise nor contains an inherent range of error, but is merely a ratio of readily measurable lengths. As such, the measurement of the ratio of two different lengths may be precise, exact, and well understood by the skilled artisan. In addition, Applicants have not introduced the term "about" into the claims in an effort to regain any subject matter that had previously been relinquished. The term is in the specification and was also in the claims as originally presented. Therefore, the use of the term "about" in the present claims should not be found to be indefinite.

This conclusion is also supported by the two other cases cited in MPEP § 2173.05(b). In *Ex Parte Eastwood*, the term "about" was found to be "clear but flexible" and "deemed to be similar in meaning to terms such as 'approximately' or 'nearly.'" See 163 U.S.P.Q. 316, 317 (B.P.A.I. 1968). Similarly, in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* ("*Gore*"), the Federal Circuit held that a limitation defining the stretch rate of a plastic as "exceeding about 10% per second" definite because infringement could clearly be assessed through the use of a stopwatch. See 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Like in *Gore*, and unlike in *Amgen*, the variable modified by the term "about" in the instant claims may also be clearly assessed and measured. The measurement of the ratio of two lengths may be precise and exact and does not contain an inherent range of error. As such, Applicants respectfully request that the Office withdraw its rejection with regards to the term "about."

B. "The machine direction" and "the cross-machine direction"

The Office has also rejected claims 80-90 under 35 U.S.C. § 112, second paragraph, asserting that the terms "the machine direction" and "the cross-machine direction" in both claims 80 and 84 lack antecedent basis. See Office Action at 2. The

Office states that “a paper napkin does not necessarily have these characteristics” and “for something to have an inherent characteristic the characteristic cannot be a probability (no matter how high) but rather a certainty.” See Office Action at 5.

Applicants have amended claims 80 and 84 herein to recite “a single-ply paper web having a machine direction and a cross machine direction.” This amendment recites that the paper webs of the instant claims do indeed have a machine direction and a cross machine direction. As such, the terms “the machine direction” and “the cross-machine direction” have a proper antecedent basis. Therefore, Applicants respectfully request that this rejection be withdrawn. In addition, it would appear that the Office did not consider any portions of the claims that include the terms “the machine direction” or “the cross-machine direction” in its evaluation of the patentability of the pending claims. Therefore, because those terms now have proper antecedent basis, Applicants request that the Office please consider all language recited in the pending claims in its further evaluation and prosecution of this application.

III. Rejections Under 35 U.S.C. § 102

A. Lazar

The Office has rejected claims 80-81, 84, 86, and 90 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,256,334 to Lazar (“Lazar”). In particular, the Office believes that Lazar discloses a method of making a paper napkin comprising providing a first transverse fold by folding one free edge towards the other free edge to create two panels, and further folding the first transverse fold towards the free edge to create a

second transverse fold and thus a four paneled web. See Office Action at 3. Applicants respectfully traverse this rejection.

As noted in Applicant's Interview Summary in Reply to the Office Action dated March 22, 2006, the Office has apparently agreed that Lazar does not teach or suggest any folds in the machine direction. In contrast, the process of Lazar, as described in particular on page 1, line 104 through page 2, line 2, would clearly indicate to the skilled artisan that its folds are in the cross-machine direction. As noted on page 11 of the Reply to Office Action dated October 6, 2005, longitudinal folding results in transverse folds, while transverse folding results in longitudinal folds. The pending claims recite at least one transverse fold, which is in the machine direction, and no longitudinal folds, as in Lazar, which must be in the cross-machine direction. Because Lazar does not teach or suggest the machine direction folds of the pending claims, Applicants respectfully request that this rejection be withdrawn.

B. Chan

The Office rejected claims 84-85 and 88 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,716,691 to Chan ("Chan"). In particular, the Office believes that Chan discloses a method of folding a web by folding a transverse free edge towards the other free edge, creating a fold line, and subsequently folding the fold line toward the transverse free edge, creating another fold line and three panels. See Office Action at 3. Applicants respectfully traverse this rejection.

As with Lazar, Chan fails to teach or suggest that its folds are transverse folds in the machine direction with no longitudinal folds in the cross-machine direction. In fact, the particular folding structure of Chan suggests that at least one fold must be in the

cross-machine direction, due to the overall folding structure taught by the reference, thereby resulting in a longitudinal fold. Because Chan fails to teach only transverse folds in the machine direction, as recited in the pending claims, Applicants respectfully request that this rejection be withdrawn.

IV. Rejections under 35 U.S.C. § 103(a)

A. Lazar in view of the Supposed Admitted Prior Art

The Office rejected claims 82-83 and 87 under 35 U.S.C. § 103(a) as obvious over Lazar in view of Applicants' supposed Admitted Prior Art ("APA"). In particular, the Office believes that, although Lazar does not directly disclose either the dimensions or the basis weights of its products, that it would have been obvious to one of ordinary skill in the art to apply the folding method of Lazar to paper webs that achieve the recitations of claims 82-83 and 87. See Office Action at 4. The Office further states that "the previously made common knowledge modification is taken to be prior art because applicant failed to traverse the examiner's assertion of official notice." *Id.* Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must have been a reasonable expectation of success to make that modification or combination. Finally, the prior art reference(s) must teach or suggest all the claim limitations. See MPEP § 2143. The references cited in the Office Action fail to meet any of these requirements.

First, Applicants disagree with the Office and believe that a proper traverse of the Official Notice was provided in the Reply to Office Action dated October 6, 2005, on at least pages 10-11. Second, regardless of the status of the supposed APA, Applicants assert that the rejection is moot in light of the Examiner's Interview and the discussion above as to Lazar failing to teach or suggest any method of making a paper product with at least one transverse fold and no longitudinal fold. Lazar fails to teach or suggest at least those elements and the supposed APA neither remedies that deficiency nor provides any suggestion or motivation to achieve the subject matter of the pending claims. Therefore, a *prima facie* case of obviousness has not been established and Applicants respectfully request that the rejection be withdrawn.

B. Ito

The Office rejected claims 84-85 and 88-89 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,469,243 to Ito et al. ("Ito"). In particular, the Office states that "Ito describes forming transverse folds in a web in order to produce wipes. The invention contemplates multiple fold configurations as well as materials." Office Action at 4. Applicants respectfully traverse this rejection.

Ito does not teach or suggest the method of the pending claims. As is clear from its specification, and in particular Figure 1, the process disclosed in Ito operates only on continuous rolls of paper, not a single-ply paper web having a machine direction and a cross machine direction, wherein a longitudinal dimension is in the machine direction and a transverse dimension is in the cross-machine direction, and wherein the longitudinal dimension is at least about two times the transverse dimension. Ito simply does not teach or suggest such a paper web having at least the dimensions and

structure recited in the pending claims. Therefore, the reference fails to teach or suggest each and every limitation of the instant claims and cannot properly form the basis of a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

V. Conclusion

Applicants submit that none of the references of record either teach or suggest the methods recited by the pending claims of this application. As such, those references, whether taken alone or in any combination, fail to either anticipate or render obvious the pending claims. Therefore, Applicants respectfully request that the rejections be withdrawn and the pending claims passed to allowance.

If the Office has any questions regarding this Response or the application, Applicants invite the Office to contact the undersigned representative at the information listed below. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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